

REMARKS/ARGUMENTS

Claims 1-16 are pending in this application. No claims are amended, canceled, or added. Therefore, claims 1-16 are present for examination, and claims 1, 11, and 16 are the independent claims.

The Final Office Action dated November 15, 2006 ("Final Office Action") rejected claims 1, 6, 11 and 16 under 35 U.S.C. §102(e) as anticipated by the cited portions of U.S. Patent No. 6,289,347 to Giroux ("Giroux"). Claims 2-3, 5 and 15 were rejected under 35 U.S.C. §103(a) as unpatentable over Giroux in view of the cited portions of U.S. Patent Publication No. 2006/0012473 A1 to Bishop et al. ("Bishop"). Claims 4, 7-10 and 12-14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Giroux and further in view of the cited portions of U.S. Patent No. 5,799,285 to Klingman et al. ("Klingman"). Applicants respectfully request reconsideration for the reasons that follow.

35 U.S.C. §102(e)/103(a) Rejection, Giroux et al.

The Office Action rejected independent claims 1, 11 and 16 under 35 U.S.C. §102(e) as anticipated by Giroux, but significant limitations from independent claims 1, 11, and 16 are neither taught nor suggested therein. More specifically, the reference cannot be relied upon to teach or suggest 1) "receiving an identifier in response to a request to audit a form" or 2) "verifying whether the form identifier is a valid form identifier for the form to be audited," as recited in claim 16. Similar limitations are also found in independent claims 1 and 11.

The Office Action relies on Giroux to teach these limitations (Final Office Action, p. 3, ll. 19-22, *citing* Giroux, col. 3, ll. 30-36; col. 6, ll. 10-31). In the previous Response filed August 29, 2006, Applicants set forth specific differences between the claims and Giroux. However, the Final Office Action maintained the rejection on largely the same basis as the previous Office Action. Applicants, however, are unable to discern from the Final Office Action how the cited references teach the identified limitations. Applicants, therefore, respectfully request the following clarifications.

1. Receiving an Identifier in Response to a Request to Audit a Form:

Applicants first turn to the limitation reciting wherein the host "receive[s] the form identifier in response to a request to audit a form," found in claim 16 (similar limitations are also found in independent claims 1 and 11). As noted, Applicants are unable to discern how Giroux teaches this limitation.

Applicants, therefore, respectfully request the following information from the Examiner so that an appropriate Response can be prepared:

1. Who in Giroux makes the **request to audit a form**?
2. What in Giroux constitutes the **request to audit a form**?
3. Who in Giroux provides the **form identifier**?
4. How is the form identifier provided **in response** to the **request to audit a form**?

The Office misstates this limitation in the Final Office Action, instead reciting the limitation as "receiving the form identifier in response to a **request audit form**" (emphasis added, Final Office Action, p. 10). It is respectfully suggested that "receiving the form identifier in response to a **request audit form**" is different than "receiving the form identifier in response to a **request to audit a form**" recited in the claims at issue (emphasis added).

Applicants believe that a review of the limitations in light of these issues will illustrate the differences between the claims and the cited art. In addition, the **Discussion** below will further highlight these distinctions.

2. Verifying whether the Form Identifier is a Valid Form Identifier for the Form to be Audited:

Applicants next turn to the limitation wherein the host "verif[ies] whether the form identifier is a valid form identifier for the form to be audited," found in claim 16 (similar limitations are also found in independent claims 1 and 11). Applicants are again unable to discern how Giroux teaches this limitation.

Applicants, therefore, respectfully request the following information from the Examiner so that an appropriate Response can be prepared:

1. What in Giroux constitutes the verification as to whether there is a valid form identifier?

2. What in Giroux constitutes the auditing?

Applicants believe that a review of the limitations in light of these issues will further focus the Examination on the relevant issues. The discussion which follows will further highlight distinctions between the claims and Giroux.

3. Discussion

The Giroux reference, instead of teaching the above limitations, merely describes a system for caching HTML forms for more efficient delivery (Giroux, Abstract, ll. 16-17; col. 4, ll. 51-52). A "host or server system ... [acts] as a forms repository for user systems. Intermediate systems maintain libraries of HTML forms. Database requests are made by a user utilizing a standard Web browser. A database query is transmitted to a server system where it is processed. The response to the query is transmitted back to the intermediate system. The intermediate system will then check to see if it currently has the appropriate form matching the query response. If not, the form is requested from the server system." (*Id.*, col. 3, ll. 30-38).

Giroux, therefore, essentially described a system for caching HTML forms at an intermediate server (i.e., the intermediate system and its local forms database; Giroux., col. 4, l. 62; col. 5, l. 6; col. 6, ll. 19-23; FIG. 1, Ref. Num. 74). A particular form and form number are requested, and this intermediate system checks to see if there is a locally cached version of the form (*Id.*, col. 6, ll. 19-28). If not, it retrieves the form by requesting it from the server 60. The reference states that this "... 'efficient' mode of operation significantly reduces the amount of bandwidth required to transmit data across the Internet, and ... allows for significantly greater throughput" (*Id.*, col. 4, ll. 59-64). Thus, the intermediate caching system of Giroux tries to *locate* an identified form locally so as to allow more efficient delivery.

But this HTML form caching system described above is different than the forms auditing system of the claims. An attempt by the intermediate system to *locate* a locally cached form in Giroux is different than the audit of the claims. The audit of the claims determines whether there is a *valid* form identifier. An attempt to *locate* a cached version of a form clearly differs from a determination of whether a particular version of a form is *valid*. The audit of the claims relates to the *validity* of a form (via its identifier), which is a different limitation than the determination of whether a form is *present* at the location. The request to audit a form, and the response thereto, are simply not present in Giroux. Answers to the above interrogatories will illustrate these distinctions. Giroux therefore fails to teach "receiving an identifier *in response to a request to audit a form*," as recited in claim 16.

Moreover, claim 16 further recites "verifying whether the form identifier is a valid form identifier for the form to be audited." Again, Giroux fails to teach or suggest the determination of whether a form or its identifier is valid. Instead, the intermediate system simply attempts to locate a particular form cached in a local database to provide more efficient delivery. The claimed forms auditing is absent from Giroux - the lookup of a locally cached version of a form is different than verifying a valid form identifier in auditing a form.

In light of the foregoing, Applicants respectfully submit that the specified limitations in independent claims 1, 11, and 16 are allowable for at least the foregoing reasons. Claims 2-10, and 12-15 each depend from these independent claims, and are believed allowable for at least the same reasons as given above. Applicants respectfully request that the rejections to claims 1-16 under 35 U.S.C. §§102(e) and 103(a) be withdrawn.

35 U.S.C. §103(a) Rejection, Giroux, Bishop

Claims 2-3, 5 and 15 are rejected under 35 U.S.C. §103(a) as unpatentable over the cited portions of Giroux and further in view of Bishop. As a threshold matter, a *prima facie* rejection has not been properly set forth for these claims. Cites to Bishop are not proper, as this reference is not prior art. Bishop is a Patent Publication with a filing date of December 9, 2004. The present application was filed December 26, 2001.

In the Final Office Action, the Office notes that the issue was not specifically raised in the Response when the reference was initially cited. The Office appears to assert that this fact transforms Bishop into prior art. Applicants are not aware of legal precedent for such an assertion, and respectfully request that the Examiner cite such precedent. Applicants also note that grounds of rejection for which Bishop was initially raised were withdrawn.

To set forth a proper *prima facie* case, a cite to actual prior art is required. While Bishop is a CIP to a number of earlier patents, the only proper citation is to a parent with an earlier priority date, and in which a cited limitation is found. Applicants respectfully request that the rejections to claims 2-3, 5 and 15 under 35 U.S.C. § 103(a) be withdrawn on these grounds as well.

CONCLUSION

For at least the foregoing reasons, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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